

# PATENT

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another and materially different process. The Examiner's "showing" consists of the following two sentences:

"In the instant case there are varied methods of producing the textured substrates as claimed that include patentably distinct methods. Additionally, the reproduction methods of Group III are contingent on the specific manipulations of Group I and are also drawn to varied patentably distinct methods."

The first sentence is a statement that the claimed textured substrates can be made by different patentably distinct methods. This does not even amount to a statement, far less a "showing" that the product "as claimed" can be made by another process (i.e. other than the claimed process).

Additionally, with regard to the restriction to Groups I, II or III, or the restriction to a species, a restriction (note that under 802.02 an election of species requirement is a "Restriction"), is only proper when the overriding two conditions required by M.P.E.P. §803 are present:

"There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see MPEP Section 802.01, Section 806.04, Section 808.01) or distinct as claimed (see MPEP Section 806.05 - Section 806.05(i)); and

(B) There must be a **serious burden** on the examiner if restriction is required (see MPEP Section 803.02, Section 806.04(a) - Section 806.04(i), Section 808.01(a), and Section 808.02)." (emphasis added)

Further, as stated immediately under the "Guidelines" sub-title of M.P.E.P §803:

"Examiners must provide reasons and/or examples to support conclusions, but need not cite documents to support the requirement in most cases."...

"For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search as defined in MPEP Section 808.02."

In the present case the Examiner has not made a *prima facie* showing of a serious burden for restriction with respect to the Groups or different species by any of the above means. In fact, the Examiner has not even attempted to do so. In addition

though, not only has there been no *prima facie* showing in the present case, but the claims themselves indicate that there is no serious burden in examining, for example, Groups I and II together. In particular, given that claim 23 (Group II) recites using processes recited within claim 1 (Group I), the Examiner in searching Group II, would have to consider art relevant to the processes of Group I in any event. Also, with regard to Group III the Examiner states that "the methods of Group III are contingent on the specific manipulations of Group I...". Therefore, following this logic, in order for the Examiner to examine Group III he would have to consider art in Group I. Thus, the Examiner's statement actually indicates that there is also no serious burden in examining Group III over Group I.

The above requirements are further echoed in M.P.E.P 808.02, which requires that when related inventions (which all of the claimed products and methods of the present case are) are distinct, then:

"the examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following:

- (A) Separate classification thereof: ...
- (B) A separate status in the art when they are classifiable together: ...
- (C) A different field of search:...

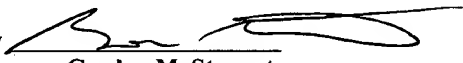
Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, **no reasons exist for dividing among related inventions.**"

Again, the Examiner has not met any of the required showings with regard to the different Groups or species (and indeed has not even attempted to do so). That being the case, the Examiner has not made the *prima facie* showing required of him by M.P.E.P. 803. Accordingly, the restriction requirement to Groups or species as set out in the Office Action should be withdrawn and the Examiner should Examine all of the claims on their merits.

Respectfully submitted,

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GP 1756  
PATENT APPLICATION

ATTORNEY DOCKET NO. 10972039-2

IN THE  
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Sally A. Swedberg, et al.

Serial No.: 09/233694

Examiner: C. Young

Filing Date: Jan 19, 1999

Group Art Unit: 1756

Title: A Method For Producing High-Surface Area Texturing Of A Substrate, Substrates Prepared Thereby And Masks For Use Therein

ASSISTANT COMMISSIONER FOR PATENTS  
Washington, D.C. 20231

TRANSMITTAL LETTER FOR RESPONSE/AMENDMENT

Sir:

Transmitted herewith is/are the following in the above-identified application:

- (X) Response/Amendment ( ) Petition to extend time to respond  
( ) New fee as calculated below ( ) Supplemental Declaration  
( ) No additional fee (Address envelope to "Box Non-Fee Amendments")  
( ) Other: \_\_\_\_\_ (fee \$ \_\_\_\_\_)

CLAIMS AS AMENDED BY OTHER THAN A SMALL ENTITY						
(1) FOR	(2) CLAIMS REMAINING AFTER AMENDMENT	(3) NUMBER EXTRA	(4) HIGHEST NUMBER PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEES
TOTAL CLAIMS		MINUS		= 0	X \$18	\$ 0
INDEP. CLAIMS		MINUS		= 0	X \$78	\$ 0
[ ] FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM					+ \$260	\$ 0
EXTENSION FEE	1ST MONTH \$110.00	2ND MONTH \$380.00	3RD MONTH \$870.00	4TH MONTH \$1360.00		\$ 0
OTHER FEES						\$
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT						\$ 0

Charge \$ 0 to Deposit Account 50-1078. At any time during the pendency of this application, please charge any fees required or credit any overpayment to Deposit Account 50-1078 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 50-1078 under 37 CFR 1.16, 1.17, 1.19, 1.20 and 1.21. A duplicate copy of this sheet is enclosed.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.

Date of Deposit: April 24, 2000

Typed Name: Leonor S. Tuck

Signature: Leonor S. Tuck

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